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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Cricket Internet Service Company

Serial No. 75/608,537

Mark A. Watson of Stafford, Stewart & Potter for Cricket
Internet Service Company.

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Before Quinn, Hairston and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On December 18, 1998, Cricket Internet Service Company
(applicant) applied to register the mark KRICKET INTERNET
SERVICE and design shown below on the Principal Register
for "providing multiple-user access to a global
communication information network" in International Class

38.¹ Applicant has also disclaimed the words "Internet Service."



The examining attorney ultimately refused to register the mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), because of two registrations for the mark CRICKET² and CRICKET COMMUNICATIONS.³ Both registrations are owned by the same entity (Cricket Communications, Inc), in typed form, and for the same services: "Telecommunications services, namely, offering personal communications services via wireless networks; and providing cellular telephone services and personal communication network (PCN) services" in International Class 38.

After the examining attorney made the refusal final, this appeal followed.

¹ Serial No. 75/608,537. The application contained an assertion of a date of first use and a date of first use in commerce of May 1, 1998.

² Registration No. 2,359,369 issued June 20, 2000.

³ Registration No. 2,359,368 issued June 20, 2000. The registration contains a disclaimer of the term "Communications."

The examining attorney's position is that while the marks are not identical, "the applicant's mark comprises the phonetic equivalent of the dominant, unique and arbitrary wording of the registrant's marks, and has either added or replaced generic wording with other wording as well as provided a pictorial representation of that same wording." Brief at 5. Regarding the relatedness of the services, the examining attorney "provided a representative sampling of seven (7) U.S. registrations each showing ... the services of both the applicant and the registrant." Brief at 10.⁴ The examining attorney also determined that because "[p]resent-day cellular telephone services provide wireless web/Internet and emailing services and capabilities," the services are related. Brief at 9.

Applicant, on the other hand, maintains that potential customers "can easily distinguish the stylized mark of applicant from the mundane, block-letter marks of the prior

⁴ Five of the seven registrations are based on ownership of a foreign registration (15 U.S.C. § 1126) with no allegation of use in commerce. See Registration Nos. 2,356,952; 2,308,192; 2,367,890; 2,242,357; and 2,297,550. While applicant has not objected to these registrations, they have little, if any, persuasive value. Also, the examining attorney's brief inexplicably contains a reference to the content of applicant's website. Inasmuch as this reference has been presented for the first time on appeal, it is not properly of record and we will not consider it. 37 CFR § 2.142(d). The examining attorney is reminded that if he would like to introduce additional evidence after an appeal is filed, a request for remand is the appropriate vehicle. Id.

registrants." Brief at 8. Regarding the services, applicant argues that "an internet provider, would not be advertising, marketing, or pursuing business in the same markets where personal communications, wireless networks and cellular telephones are marketed." Brief at 12. Applicant then concludes by arguing that "each Dupont [In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973)] factor of which evidence can be found in the record, weighs in favor of registration of applicant's proposed mark." Brief at 17.

In a case involving a refusal under Section 2(d), we analyze the facts as they relate to the relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also du Pont, 177 USPQ at 567; Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000).

We begin by comparing applicant's and registrant's marks. Applicant's mark consists of the words KRICKET INTERNET SERVICE and the design of a cricket; registrant's marks are CRICKET and CRICKET COMMUNICATIONS in typed form. The marks are dominated by the same word, "cricket" or "kricket." There is no evidence that "cricket" is anything other than an arbitrary term in relationship to applicant's and registrant's services. The words "cricket" and

"kriicket" are also phonetic equivalents. In addition, applicant uses the design of a cricket in its mark, which emphasizes the term "cricket." Inasmuch as the design is a pictorial representation of the word found in the marks, it would not serve to distinguish the marks in meaning or appearance.

Regarding the additional wording "internet service" in applicant's mark, this disclaimed term would not significantly distinguish the marks. In a similar case, the Federal Circuit held that the addition of the word "Swing" to registrant's mark "Laser" did not result in the marks being dissimilar. "[B]ecause both marks begin with 'laser,' they have consequent similarities in appearance and pronunciation. Second, the term 'swing' is both common and descriptive... Regarding descriptive terms this court has noted that the descriptive component of a mark may be given little weight in reaching a conclusion on likelihood of confusion." Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1845-45 (Fed. Cir. 2000) (citations and quotation marks omitted). See also In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997) (Court held that the addition of "The," "Cafe" and a diamond-shaped design to registrant's DELTA mark still resulted in a likelihood of confusion); Wella Corp. v.

California Concept Corp., 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (CALIFORNIA CONCEPT and surfer design likely to be confused with CONCEPT for hair care products). Even when the registered mark CRICKET COMMUNICATIONS is compared to applicant's mark, since the terms "Communications" and "Internet Service" would be highly descriptive of the services offered under the marks, the public would likely assume that the additional wording in the marks identifies a different service offered by the registrant under the CRICKET mark. In addition, applicant's argument about the "mundane, block-letter marks of the prior registrants" (Brief at 8) is not accurate. Registrant has depicted its mark in a typed drawing. Therefore, it is not limited to any special form. Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983); Cunningham, 55 USPQ2d at 1847-48.

When we view the marks, it is clear that they are not identical. However, "[s]ide-by-side comparison is not the test. The focus must be on the 'general recollection' reasonably produced by appellant's mark and a comparison of appellee's mark therewith." Johann Maria Farina Gegenuber Dem Julichs-Platz v. Chesebrough-Pond, Inc., 470 F.2d 1385, 176 USPQ 199, 200 (CCPA 1972) (citation omitted). Here, when we compare the marks in their entireties, we find that

they are dominated by the phonetically identical term "cricket." Applicant's design emphasizes the "cricket" portion of the mark, and the words are very similar in sound, appearance, meaning, and commercial impression.

We now move on to discuss whether the services of applicant and registrant are related. "In order to find that there is a likelihood of confusion, it is not necessary that the goods or services on or in connection with which the marks are used be identical or even competitive. It is enough if there is a relationship between them such that persons encountering them under their respective marks are likely to assume that they originate at the same source or that there is some association between their sources." McDonald's Corp. v. McKinley, 13 USPQ2d 1895, 1898 (TTAB 1989). See also In re Opus One Inc., 60 USPQ2d 1812, 1814-15 (TTAB 2001). We must consider the services as they are identified in the application and registration. Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods"); Dixie Restaurants, 41 USPQ2d at 1534 (punctuation in original), quoting, Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1

USPQ2d 1813, 1816 (Fed. Cir. 1987) ("Likelihood of confusion must be determined based on an analysis of the mark applied to the ... services recited in applicant's application vis-à-vis the ... services recited in [a] ... registration, rather than what the evidence shows the ... services to be").

Applicant's services are identified as "providing multiple-user access to a global computer information network." In effect, applicant is "an internet provider." Applicant's Brief at 12. Registrant provides "telecommunications services, namely, offering personal communications services via wireless networks; and providing cellular telephone services and personal communication network (PCN) services." "Personal communications services" are defined as the "second generation cellular telephone services, with the following advantages over the traditional analog cellular telephone services ... Digital services, such as Internet access, stock quotes and paging can be made part of the service." M. Shnier, *Computer Dictionary* (1998), p. 486.⁵ Therefore, inasmuch as registrant's personal communications services

⁵ We take judicial notice of this definition. University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

can include providing Internet access, applicant's argument that the services are distinct is not viable.

We also look to the examining attorney's use-based registrations, which provide some suggestion that applicant's and registrant's services may originate from the same source. See Registration No. 2,181,197 (multiple-user access to a global computer information network and telecommunications services) and No. 2,232,684 (personal communications services including wireless communications and wireless global communications access). These registrations suggest that the same source may provide both telecommunications and internet services. See In re Mucky Duck Mustard Co., 6 USPQ2d 1467, 1470 n.6 (TTAB 1988) (Although third-party registrations "are not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, [they] may have some probative value to the extent that they may serve to suggest that such goods or services are the type which may emanate from a single source"). See also In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1786 (TTAB 1993). In the balance, we find that applicant's internet services and registrant's personal communications services are related to the extent that when very similar marks are used in connection with the services, potential customers are

likely to believe that there is at least some association between the source of the services.

Applicant argues that the trade channels are different because "the holder of the previous registrations is based in California while applicant is based in Louisiana."

Brief at 15. First, we note that there is no evidence of where registrant uses its mark. The mere fact that registrant has a California address does not limit its activities to California or even the western part of the United States. Second, since registrant has obtained a geographically unrestricted registration, there is no basis to distinguish the trade channels based on geography.

Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 218 USPQ 390, 393 (Fed. Cir. 1983) ("Section 7(b) of the Trademark Act of 1946, 15 U.S.C. §1057(b), creates a presumption that the registrant has the exclusive right to use its mark throughout the United States. Therefore, the geographical distance between the present locations of the respective businesses of the two parties has little relevance in this case"); Amcor, Inc. v. Amcor Industries, Inc., 210 USPQ 70, 73 (TTAB 1981) ("[T]he possible geographical separation between the parties, although the evidence does show an overlap on occasion, is of no significance in this proceeding because applicant is

seeking territorially unrestricted registrations for its marks and, if granted, the presumptions afforded the registrations under Section 7(b) include a presumption of use or the right to use the registered marks throughout the United States").

Applicant also argues that "the conditions under which sales are made and the buyers to whom sales are made, also weighs in favor of registration." Brief at 15. The mere fact the potential customers are purchasing computer-related services does not make them sophisticated purchasers. Almost twenty years ago, the Board held that computer purchasers were not necessarily sophisticated purchasers. In re Graphics Technology Corp., 222 USPQ 179, 181 (TTAB 1984) ("[W]hatever the situation may have been a decade or a generation ago, today's computer buyers cannot be uniformly classified as a technically adept or highly discriminating purchaser group"). Similarly, there is no evidence that applicant's and registrant's services would be marketed almost exclusively to sophisticated purchasers.

While applicant argues that there is no evidence of fame, the absence of this evidence is of no consequence. This type of evidence would not normally be of record in an ex parte case and the lack of such evidence does not indicate that there is no likelihood of confusion. See

Majestic Distilling, 65 USPQ2d at 1205 (citation omitted) ("Although we have previously held that the fame of a registered mark is relevant to likelihood of confusion, we decline to establish the converse rule that likelihood of confusion is precluded by a registered mark's not being famous"). Another point applicant makes is that applicant has alleged a date of use earlier than registrant's filing date. However, this is not relevant since we do not determine priority in an ex parte proceeding. In re Calgon Corp., 435 F.2d 596, 168 USPQ 278, 280 (CCPA 1971) ("As the board correctly pointed out, 'the question of priority of use is not germane to applicant's right to register' in this ex parte proceeding"). See also In re Kent-Gamebore Corp., 59 USPQ2d 1373, 1374 n. 3 (TTAB 2001).

Applicant maintains that "[s]uffice it to say there are voluminous trademarks with the word "Cricket." However, applicant has not made any third-party registrations of record. Indeed, there is no evidence to suggest that "cricket" is anything other than an arbitrary term when applied to the services in this case. We do not hesitate to add that even if third-party registrations had been made of record, they cannot be used to justify the registration of another confusingly similar mark. In re J.M. Originals, 6 USPQ2d 1393, 1394 (TTAB 1988).

Finally, applicant observes that there is no evidence of actual confusion. Again, this fact does not demonstrate that there is no likelihood of confusion. Majestic Distilling, 65 USPQ2d at 1205 ("The lack of evidence of actual confusion carries little weight").

Our analysis of all the factors leads us to conclude that when applicant's and registrant's marks are used on the identified services, there would be a likelihood of confusion. If we had any doubts concerning this issue, which we do not, "this is a proceeding in which registrant has no opportunity to be heard on this question and it is the practice to resolve doubt under Section 2(d) with the registrant." In re Mayco Mfg., 192 USPQ 573, 576 (TTAB 1976).

Decision: The refusal to register applicant's mark under Section 2(d) is affirmed.